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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,396	09/23/2003	John C. Goodwin III	11486.00	2509

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EXAMINER

ARAQUE JR, GERARDO

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,396

Applicant(s)

GOODWIN, JOHN C.

Examiner

Gerardo Araque Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/9/2003.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1 – 21** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As best understood by the examiner, the applicant has failed to properly disclose the relationship of the first, second, third, and fourth items. That is to say, each item has their own identification information associated with their respective radio frequency identification labels and each of the items are being compared with each other. However, the specification makes no mention how and why the identification of each item is being compared to the other in order to come to the conclusion that an item is an item that was brought into the store by a shopper. Further still, the examiner is also

uncertain as to how the third identification information is determined using second identification when both identifications are associated with two different items. As a result, the current claims are disclosed in a manner that is inconsistent with the disclosure of the invention in that there is subject matter not properly supported by the claim. Moreover, because the claims are not fully supported by the specification, it leads the examiner to believe that the invention is not fully disclosed and that essential methods are being omitted from the specification, which would result in undue experimentation.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1 – 21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claims 1 and 11** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: distinguishing items for sale from items brought into the store.

7. **Claims 1 and 11** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the result of the comparison of the second identification information to the first identification information.

8. In regards to **claims 1 and 11**, the examiner is uncertain as to what the applicant is attempting to claim. As best understood by the examiner, the invention according to the claims is as follows:

- The identification (ID 1) of item 1, which is associated on a RFID (RFID 1), is stored in some type storage medium. Item 1 being sold at the store.
- The identification (ID 2) of item 2 (completely different from item 1), which is associated on another RFID (RFID 2), is obtained using a RFID reader. The examiner is unsure as to whether or not item 2 is being sold at the store, is being brought into the store, or is just a random item that happens to be in the store.
- Comparing ID 1 of RFID 1 and ID 2 of RFID 2. The examiner is unsure as to why this is being done since nothing comes of the comparison. That is to say, what are the results of the comparison used for, if any results are attained?
- Discovering a third identification (ID 3) found on item 3, which is associated on a RFID (RFID 3), within ID 2 of RFID 2. The examiner does not understand how this is accomplished. How can another ID for a completely different item be associated on another completely different item that has its own ID? What is even more confusing is that in **claim 11**, the examiner is uncertain as to whether it is ID 2 or ID 3 is not within ID 1, which renders the result of the comparing step of no use. Further still, in

regards to claim 11, the examiner is uncertain as to role of ID 4 found on RFID 4 on item 4. Item 4 being a completely different item.

- Ignoring ID 3. If it is being ignored how is ID 3 affecting any of the previous steps, e.g. how is step d accomplished?

As a result, the examiner is uncertain as to what to search for. For the purposes of the examination, the examiner will assume that the invention is as follows:

The identification of an item is stored in a computer system and at the point of purchase the item is scanned in order to acquire its identification; the identification being transmitted from an RFID found on the item. Once the item has been purchased, the RFID will then emit a modified identification indicating that the item has already been purchased and the customer is then able to safely exit the store.

In the event that a shopper walks into a store with an item that contains an RFID device, a check is made at some point after entering the store as to whether or not the item has already been purchased. An example of such a scenario is when a customer walks into a store with an electronic device that contains an RFID on it. The electronic device being an item that was not originally brought at the store that the customer has walked into. If the item triggers the alarm of the store, the item is then scanned to determine whether or not the item was stolen from the store by comparing its identification to those stored in the store's computer.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 14 – 21** are rejected under 35 U.S.C. 102(b) as being anticipated by **Johnsen (US Patent 5,151,684)**.

11. In regards to **claim 14**, as best understood by the examiner, **Johnsen** discloses a system for distinguishing items for sale by a store from items brought into the store by a shopper comprising:

a label reader for reading radio frequency identification labels on items the shopper possesses (**Column 6 – 7 Lines 67 – 1**); and

a computer for obtaining identification information from first radio frequency identification labels on the items the shopper possesses from the label reader, for comparing the first identification information to second identification information associated with the items for sale by the store, for determining third identification information within the first identification information which is associated with third radio frequency identification labels on third items, and for ignoring the third identification information as being associated with the items brought into the store by the shopper (**Column 2 Lines 59 – 68; Column 5 Lines 20 – 31; Column 6 Lines 1 – 31**).

12. In regards to **claim 15**, as best understood by the examiner, **Johnsen** discloses wherein the computer comprises a transaction computer (**Column 3 Lines 41 – 51**).

13. In regards to **claim 16**, as best understood by the examiner, **Johnsen** discloses wherein the computer comprises a security computer (**Column 5 Lines 20 – 31**).

14. In regards to **claim 17**, as best understood by the examiner, **Johnsen** discloses wherein the computer determines that the third identification is not within the second identification information (**Column 2 Lines 59 – 68**).

15. In regards to **claim 18**, as best understood by the examiner, **Johnsen** discloses wherein the computer determines that the third identification is within the second identification information, but determines that the third items were previously sold (**Column 2 Lines 59 – 68**).

16. In regards to **claim 19**, as best understood by the examiner, **Johnsen** discloses wherein the computer also determines fourth identification information within the second identification information which is associated with fourth radio frequency identification labels on the fourth items which are included within the first items for sale, and includes the fourth items in a transaction involving the shopper in the store (**Column 2 Lines 59 – 68; Column 3 Lines 15 – 51**).

17. In regards to **claim 20**, as best understood by the examiner, **Johnsen** discloses wherein the computer also stores an indication that the fourth items were sold (**Column 2 Lines 59 – 68; Column 3 Lines 15 – 51**).

18. In regards to **claim 21**, as best understood by the examiner, **Johnsen** discloses wherein the computer also purges the fourth identification information from the second identification information (**Column 2 Lines 59 – 68; Column 3 Lines 15 – 51**).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 1 – 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Johnsen (US Patent 5,151,684)** in view of **Applicant's Admitted Prior Art (AAPA)**.

21. In regards to **claim 1**, as best understood by the examiner, **Johnsen** discloses a method of distinguishing items for sale by a store from items brought into the store by a shopper comprising the steps of:

- a) storing first identification information associated first radio frequency identification labels on first items for sale by the store (**Column 3 Lines 33 – 34**);
- b) obtaining second identification information from second radio frequency identification labels on second items by a label reader in the store (**Column 3 Lines 41 – 45**);
- c) comparing the second identification information to the first identification information (**Column 3 Lines 46 – 51**);
- d) determining third identification information within the second identification information which is associated with third radio frequency identification labels on third items (**Column 3 Lines 16 – 23**); and

However, **Johnsen** fails to disclose:

- e) ignoring the third identification information as being associated with the items brought into the store by the shopper.

However, **AAPA** discloses that it is old and well known to have RFID labels permanently attached to merchandise items (**Background of the Invention ¶ 3**).

Although, **Johnsen** discloses that the tag is removed upon purchase **Johnsen** discloses that the surveillance system is capable of monitoring RFID devices in the store as well as tracking which items have been purchased (**Column 5 Lines 20 – 31; Column 6 Lines 1 – 31; Column 8 Lines 56 – 61**). One skilled in the art would have found it obvious that the system as disclosed by **Johnsen** would also pick up any other RFID device in the vicinity of its surveillance sensors and determine whether or not it is part of its database in order to determine if any theft has occurred in the event that the RFID device was not reprogrammed to “sold.” Further still, if the system does not register the RFID device when comparing it to what is stored in its database it would obviously ignore the RFID device and continue on monitoring the rest of the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Johnsen** in view of the teachings of **AAPA** to also monitor any other RFID devices that come within the vicinity of the surveillance sensors in order to determine if any theft has occurred.

22. In regards to **claims 2 – 3 and 12 – 13**, as best understood by the examiner, **Johnsen** discloses wherein step e) comprises the step of:

e-1) leaving the third identification information out of a transaction in the store (**Obviously included in that if the third identification information is being ignored it would not be picked up by any sensors in the store and would further result in having the item omitted from any transactions as well as any security checks**).

23. In regards to **claims 4 – 10**, as best understood by the examiner, **Johnsen** discloses further comprising the step of:

f) **[Claim 4]** determining fourth identification information within the second identification information which is associated with fourth radio frequency identification labels on the fourth items which are included within the first items for sale

g) **[Claim 5]** including the fourth items in a transaction involving the shopper in the store

h) **[Claim 6]** storing an indication that the fourth items were sold

h) **[Claim 7]** purging the fourth identification information from the first identification information

g) **[Claim 8]** determining that the fourth items were not paid for during a security check in the store

d-1) **[Claim 9]** determining that the third identification information is not within the first identification information

d-1) **[Claim 10]** determining that the third identification information is within the first identification information; and

d-2) **[Claim 10]** determining that the third items were previously sold.

(Obviously included in that Johnsen discloses that the invention is capable of monitoring several items at one time and able to update any information pertaining to those items, such as whether they have been sold, stolen, or being transported from one location to another. [Column 2 Lines 59 – 68; Column 3; Column 5 Lines 20 – 31; Column 6 Lines 1 – 31; Column 8 Lines 56 – 61; Column 11 Lines 1 – 40]).

24. In regards to **claim 11**, as best understood by the examiner, **Johnsen** discloses a method of distinguishing items for sale by a store from items brought into the store by a shopper comprising the steps of:

- a) storing first identification information associated first radio frequency identification labels on first items for sale by the store (**Column 3 Lines 33 – 34**);
- b) obtaining second identification information from second radio frequency identification labels on second items by a label reader in the store (**Column 3 Lines 41 – 45**);
- c) comparing the second identification information to the first identification information (**Column 3 Lines 46 – 51**);
- d) determining third identification information within the second identification information which is not within the first identification information and which is associated with third radio frequency identification labels on third items (**Column 3 Lines 16 – 23**;
Further still, as best understood by the examiner, the third identification information would obviously not be associated with the first identification information since the third identification is associated with a third item and the first identification information is associated with a first item [see also 112, second paragraph, rejection above].); and
- e) determining fourth identification information within the second identification information which is within the first identification information and which is associated with fourth radio frequency identification labels on the fourth items which are included within the first items for sale (**Obviously included in that Johnsen discloses that the**

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invention is capable of monitoring several items at one time and able to update any information pertaining to those items, such as whether they have been sold, stolen, or being transported from one location to another. [Column 2 Lines 59 – 68; Column 3; Column 5 Lines 20 – 31; Column 6 Lines 1 – 31; Column 8 Lines 56 – 61; Column 11 Lines 1 – 40]);

f) determining that the fourth items were previously sold (**Obviously included in that Johnsen discloses that the invention is capable of monitoring several items at one time and able to update any information pertaining to those items, such as whether they have been sold, stolen, or being transported from one location to another. [Column 2 Lines 59 – 68; Column 3; Column 5 Lines 20 – 31; Column 6 Lines 1 – 31; Column 8 Lines 56 – 61; Column 11 Lines 1 – 40]);** and

However, **Johnsen** fails to disclose:

e) ignoring the third and fourth identification information as being associated with the items brought into the store by the shopper (**Column Lines**).

However, **AAPA** discloses that it is old and well known to have RFID labels permanently attached to merchandise items (**Background of the Invention ¶ 3**).

Although, **Johnsen** discloses that the tag is removed upon purchase **Johnsen** discloses that the surveillance system is capable of monitoring RFID devices in the store as well as tracking which items have been purchased (**Column 5 Lines 20 – 31; Column 6 Lines 1 – 31; Column 8 Lines 56 – 61**). One skilled in the art would have found it obvious that the system as disclosed by **Johnsen** would also pick up any other RFID device in the vicinity of its surveillance sensors and determine whether or not it is

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part of its database in order to determine if any theft has occurred in the event that the RFID device was not reprogrammed to "sold." Further still, if the system does not register the RFID device when comparing it to what is stored in its database it would obviously ignore the RFID device and continue on monitoring the rest of the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Johnsen** in view of the teachings of **AAPA** to also monitor any other RFID devices that come within the vicinity of the surveillance sensors in order to determine if any theft has occurred.

Conclusion.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in PTO-892 Notice of References Cited.

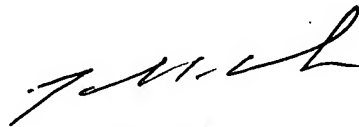
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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3/28/07


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